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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,272	09/11/2003	Hiroshi Saito	249-316	5620

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EXAMINER

PICKARD, ALISON K

ART UNIT	PAPER NUMBER
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3673

DATE MAILED: 12/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/659,272	<b>Applicant(s)</b> SAITO ET AL.	
	<b>Examiner</b> Alison K. Pickard	<b>Art Unit</b> 3673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 4-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 7, 10, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Inoue (5,743,971).

Inoue discloses a gasket comprising a metal plate and film comprising silica and two acids, which can be different (see col. 1:59-65 and col. 2-3:34, particularly col. 3:15, 16, 24, 28-29, and 32-33), and a metal. The second acid can be a fluorocomplex such as fluoro-titanic or fluoro-zirconate acid (see col. 2, lines 40-50).

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 4-6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuzaki (2003/0072962) in view of Inoue.

Matsuzaki discloses a gasket comprising a metal plate (paragraph 49), film (e.g. oxide coating), and an organic layer. The film is made from silica (paragraph 227), an acid, and a metal. The metal can be Mn, Mg, or Al. The acid and silica (and metal) can be present in the

Art Unit: 3673

percentages required by the claims (see paragraphs 235 and 236). Matsuzaki does not disclose the acid is a fluorocomplex. Inoue teaches a gasket with a film and organic layer. Inoue teaches suitable art equivalent acids, such as phosphoric acid and fluorocomplex acids. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to use a fluorocomplex as the acid instead of phosphoric acid as both are suitable acids in such films as taught by Inoue.

Matsuzaki does not specifically state the organic coating is a rubber layer, but some examples are given in paragraph 156. The selection of a known material based on its suitability for its intended use is not considered inventive. See *In re Leshin*, 125 USPQ 416 (CCPA 1960). Further, it is known that rubber, resins, polyurethanes (which can be a rubber), etc. are known coating layers used in gaskets as evidenced by Teranishi '830 (see col. 6:21-33). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to make the organic coating a rubber coating/layer. The limitation "bonded by vulcanization" is considered a process in a product claim and is given little patentable weight.

5. Claims 1, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue in view of Teranishi (6,502,830).

Inoue discloses an organic coating such as a urethane. However, Inoue does not disclose the coating is one of the materials required by the claims. Teranishi teaches a gasket with a metal plate having a corrosion resistant coating and an organic coating. Teranishi teaches that rubbers and urethanes are art equivalent materials. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to use silicone or rubber as the

Art Unit: 3673

organic coating as such is an art equivalent. The limitation "bonded by vulcanization" is considered a process in a product claim and is given little patentable weight.

***Response to Arguments***

6. Applicant's arguments filed 9-21-06 have been fully considered but they are not persuasive.

It appears Inoue discloses the fluorocomplex acids required by the claim. Inoue also teaches a variety of acids that are suitable for such films, and thus are considered art equivalents.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alison K. Pickard whose telephone number is 571-272-7062. The examiner can normally be reached on M-F (10-7:30), with alternate Friday's off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tricia Engle can be reached on 571-272-6660. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3673

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Alison K. Pickard  
Primary Examiner  
Art Unit 3673

AP